

REMARKS

Applicant thanks the Examiner for withdrawing the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

Applicant respectfully requests reconsideration of the prior art rejections set forth by the Examiner under 35 U.S.C. § 103. The Examiner has rejected claim 1 under Kurose (U.S. Patent No. 6,063,500), Abe (U.S. Patent No. 5,451,464), or Murayama (U.S. Patent No. 5,972,515) in view of Kato (U.S. Patent No. 6,114,057) and Kato (Jap. Pat. Pub. No. 2002-025035).

By this amendment, Applicant has modified independent claim 1 in order to further define the invention. More specifically, Applicant has modified independent claim 1 to additionally require that the binder not contain a vinyl group and not contain a halogen-containing resin. As noted in paragraphs 24, 28, 77, 104, 165, and 201 and in Tables 4 and 5 of Applicant's disclosure, prior art compositions utilized vinyl chloride in the binder which emits hydrogen chloride during the incineration so as to corrode an incinerator and are assumed as a dioxin-generating source. (See paragraph 17 of the reference).

As now defined, Applicant respectfully submits that claim 1 is patentably distinct over the prior art references of record. Applicant has reviewed the references and notes that neither of the primary prior art references relied upon by the Examiner provides any teaching or suggestion whatsoever regarding the presently claimed subject matter wherein a magnetic recording medium is obtained by coating on a non-magnetic support a magnetic coating material having a magnetic powder and a binder dispersed in a solvent wherein the binder contains 2 polyurethane resins, one of which is an aromatic polyester polyurethane resin and the other is a polyurethane resin obtained by urethanization of a glycol having a specified molecular weight, and wherein the binder does not contain either of a vinyl group or a halogen containing resin.

Appl. No. 10/614,373
Reply to Office Action of June 20, 2006

Applicants note that each of the Kurose, and Kato ('057 and '035) references cited by the Examiner teaches the inclusion of a vinyl group or a halogen containing resin, and therefore teaches away from Applicant's currently claimed invention. See, for example, the abstract and claim 1 of the Kurose reference, which teaches the use of a vinyl chloride binder. See the "Solution" section and paragraph [0024] of the '035 Kato reference. See Column 7, line 55 – Column 8, line 5 of the Kato '057 reference. Applicants note that the Court of Appeals for the Federal Circuit has held that "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Furthermore, counter to the Examiner's remarks on page 2 of the last Office Action, Applicants submit that the Kato '057 reference fails to teach or suggest the use of an aromatic polyester polyurethane resin obtained by urethanization of an aromatic polyester with an aromatic diisocyanate. The portion of the reference to which the Examiner cites, Column 4, line 57 – Column 5, line 11) only discloses the use of an aromatic diisocyanate. It fails to disclose the formation of an aromatic polyester polyurethane using both an aromatic polyester and an aromatic diisocyanate.

Finally, Applicants note that none of the references, alone or in combination, provide a motivation to combine. The Court of Appeals for the Federal Circuit has held that absent a motivation to combine in the prior art references themselves, picking and choosing particular aspects of prior art references to form an obviousness rejection is an unsupported and invalid exercise. The obviousness rejection must be made based upon the invention as a whole, not upon its individual parts. (See *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 959, Fed. Cir. 1986, and *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, Fed. Cir., 1997).

Appl. No. 10/614,373
Reply to Office Action of June 20, 2006

Here, even if the two Kato references fully disclosed each aspect of the claimed resins, Applicants submit that one of ordinary skill in the art would not be motivated to combine these references due to the inherent unknown interactions of these two separate resins. What's more, nothing in the references themselves provides a motivation to seek to combine the disclosed resin of one reference with the resin of the other reference. Applicants submit, rather, that one of ordinary skill in the art would choose the particular resin from the two disclosures that provided the best performance based upon the intended use of the tape. The references fail to teach or suggest anything more.

Accordingly, in light of the foregoing, because the prior art does not provide the requisite teaching or suggestion to render the claimed subject matter obvious, Applicant respectfully requests allowance of all claims.

Date: 8/20/06

Respectfully submitted,

(Reg. #37,607)

Robert J. Depke
**ROCKEY, DEPKE, LYONS &
KITZINGER, LLC**
Sears Tower, Suite 5450
Chicago, Illinois 60606-6306
Tel: (312) 277-2006
Attorneys for Applicant